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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/918,874	08/26/97	ASHKENAZI	A P1129

HM11/0710

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EXAMINER

ULM J	
ART UNIT	PAPER NUMBER

1646

DATE MAILED: 07/10/98

This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
 Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-27 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit: 1646

Claims 1 to 27 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 6, and claims 24 and 25 in so far as they encompass a kit comprising an RTD polypeptide, drawn to an isolated RTD polypeptide, classified in class 530, subclass 350.
- II. Claims 7 to 10 and 14 to 19, drawn to a nucleic acid encoding an RTD polypeptide and a chimeric protein encoded thereby, classified in class 435, subclass 69.7.
- III. Claims 11 to 13, and claims 24 and 25 in so far as they encompass a kit comprising an antibody, drawn to an antibody, classified in class 530, subclass 388.22.
- IV. Claims 20 to 23, drawn to a transgenic animal, classified in class 800, subclass 2.
- V. Claims 26 and 27, drawn to a method of treatment, classified in class 514, subclass 2.

The inventions are distinct, each from the other because:

The isolated peptide which is invention I, the isolated nucleic acid which is invention II, the antibody which is invention III and the transgenic animal which is invention IV are four structurally and materially different compositions each of which can be made and used without the other. Lack of unity is shown by the fact that these four different compositions lack a common utility which is based upon a common special technical feature disclosed as the basis for that utility. The chimeric protein is included in invention II because it is a compound which does not occur in nature and requires an isolated nucleic acid for its manufacture. The protein of claim I,

Art Unit: 1646

however, occurs in nature and can be isolated therefrom without the need for an isolated nucleic acid encoding it.

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the RTD polypeptide of invention I can be used to elicit the production of antibodies that are invention III, which is a materially different process that the "method of modulating apoptosis" which is invention V..

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A telephone call was made to Diane L. Marschang on 09 July of 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that there are no copies of the references cited in the information disclosure statement filed 22 May of 1998 present in the instant application. Applicant needs to

Serial Number: 08/918,874

Page 4

Art Unit: 1646

provide initial or replacement copies of these references in response to this action if they wish to have these references considered before a first action on the merits of the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Walsh, can be reached at (703) 308-2957.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800